

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application No.: 10/664,837  
Filing Date: September 17, 2003  
Applicant: James T. Perkins  
Group Art Unit: 3763  
Examiner: Theodore J. Stigell  
Title: PHACOEMULSIFICATION NEEDLE  
Attorney Docket: P03320 (6639-000051/US)

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

**Reply to Examiner's Answer**

Sir:

This is a reply to the Examiner's Answer mailed on 13 March 2008. The Examiner and the Applicant have a basic disagreement over what may be considered non-analogous art. The Examiner believes that a balloon catheter introducer is analogous to a phacoemulsification needle for transferring ultrasonic energy to break apart a cataract and allow the cataract tissue to be aspirated. Applicant believes the Examiner's position is unreasonable and without merit.

Applicant, in its Appeal Brief, went to great pains to point out all the differences between the balloon sheath of the prior art and the claimed present invention. The

present invention is used to destroy and remove tissue from an eye; in stark contrast, the cited prior art is for inserting a balloon into blood vessels. Applicant respectfully asserts that no reasonable person would say that the two devices are in the same field of endeavor or that the cited prior art is in anyway pertinent to the claimed invention of a phaco needle.

The Examiner asserts that Applicant's statements support his contention that the cited prior art could transmit ultrasonic energy. Applicant does not believe this contention is of any relevance to the question at hand – is the cited art analogous or not to the claimed invention. Applicant, in it's Appeal Brief, simply made the case that even though the prior art has generally similar structure, no one skilled in the art of phacoemulsification would look to the cited prior art for a solution; and similarly, the cited prior art does not teach, suggest, or even hint at being able to perform the functions of the claimed invention. The Examiner attempts to bolster his argument by stating that the cited prior art is capable of transmitting at least some ultrasonic energy for some small amount of time, whether such transmission is effective or not. Such an argument is simply spurious. Any material that is attached to a source of ultrasonic vibration will in some way transmit that vibration. Again, this assertion is not relevant to whether the prior art is non-analogous. Even if the ability of the cited prior art to transmit ultrasonic energy is relevant, the effective transmission of that energy and the ability of the cited prior art to perform as the claimed phacoemulsification cannula is of even more import. There is no indication that the cited prior art could be used as a phaco cannula, as pointed out in Applicant's Appeal Brief. In addition to all the points made in the Appeal Brief, a typical phaco cannula is less than one inch in total length.

The cited prior art indicates its total length is 3.6 inches (col. 8, line 3). Such a long length would be very difficult, if not impossible, to use in such a small, shallow space as an eye.

Applicant also respectfully disagrees with the Examiner's combination of Zadno-Azizi with Eliasen, and reiterates the arguments made in the Appeal Brief. Similarly, the Applicant also reiterates the arguments made with regard to the weight to be accorded the functional language of the appealed claims.

In view of the above and the arguments made in the Appeal Brief, it is respectfully submitted that the present invention is in condition for allowance, and such allowance is requested at an early date.

If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (314) 446-7646.

Respectfully submitted,



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DATE: May 12, 2008

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